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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/789,510

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Gabor Schmera

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10/14/2008

OFFICE OF PATENT COUNSEL

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EXAMINER

TURK, NEIL N

ART UNIT

PAPER NUMBER

1797

MAIL DATE

DELIVERY MODE

10/14/2008

PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

# Office Action Summary

**Application No.**

10/789,510

**Applicant(s)**

SCHMERA ET AL.

**Examiner**

NEIL TURK

**Art Unit**

1797

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on July 7<sup>th</sup>, 2008.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-15 is/are pending in the application.
- 4a) Of the above claim(s) 1,2 and 12-16 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 3-11 is/are rejected.
- 7) ☒ Claim(s) 9 and 11 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO/5508)  
Paper No(s)/Mail Date 2/27/04
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_

## **DETAILED ACTION**

### **Remarks**

This Office Action fully acknowledges Applicant's remarks filed on July 7<sup>th</sup>, 2008. Claims 1-16 are pending. Claims 1, 2, and 12-16 have been withdrawn from consideration as being drawn to non-elected inventions.

### ***Election/Restrictions***

Applicant's election without traverse of Group II, claims 3-11, in the reply filed on July 7<sup>th</sup>, 2008 is acknowledged.

### ***Claim Objections***

**Claim 9** is objected to under 37 CFR 1.75(c), as being of improper dependent form for failing to further limit the subject matter of a previous claim. Applicant is required to cancel the claim(s), or amend the claim(s) to place the claim(s) in proper dependent form, or rewrite the claim(s) in independent form. Claim 9 does not further limit claim 3 or 4, as the only measurement means described in Applicant's specification is to a frequency fluctuation counter. Thereby, in claim 3 the measurement means is read as the frequency fluctuation counter.

**Claim 11** is objected to under 37 CFR 1.75(c), as being of improper dependent form for failing to further limit the subject matter of a previous claim. Applicant is required to cancel the claim(s), or amend the claim(s) to place the claim(s) in proper

dependent form, or rewrite the claim(s) in independent form. Claim 11 recites that the decision means comprises a pattern recognizer. This portion of the claim does not further limit claims 3 or 4. This is seen as Applicant's specification only describes the decision means as a pattern recognizer. Thereby, in claim 3 the decision means is read as the pattern recognizer. The second portion of claim 11 relating to the pattern recognizer's function properly further limits claims 3 and 4.

### ***Claim Rejections - 35 USC § 112***

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

**Claims 3-11** are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Claim 3 recites a theoretical amplitude density function  $P(r,n)$ , however such a function is indefinitely recited as the actual function has not been recited. What is the function  $P(r,n)$ ? Does Applicant intend to recite the function that is designated as Eq. 1 on page 10 of Applicant's specification? Clarification is required so as to definitely recite the decision means in conjunction with the amplitude density and outputting a signal representative of the total number of molecules absorbed.

Further, with regards to claims 3-11 it is unclear how such a function  $P(r,n)$  is operative with the decision means and amplitude density signal. That is, on page 10 of Applicant's specification, it is detailed that in the function  $P(r,n)$ ,  $r$  is a non-negative integer and represents the number of molecules on an active zone. As claim 3 does not recite an active zone, it is unclear how the decision means may generate such an analyte output signal. Further, Applicant's specification on page 10 relates the amplitude density function  $P(r,n)$  specially to a SAW device. As claim 3 does not recite a SAW device, it is unclear how the decision means may generate such an analyte output signal. Does Applicant intend to recite the limitations of claims 4 and 5, which bring in these mentioned elements?

Further, with regard to claim 3, the amplitude density function  $P(r,n)$  is described on page 10 of Applicant's specification as also being dependent upon  $p$ , where  $p$  is the ratio of the area of the active zone to that of the total area of the surface of the SAW device. Such that claim 3 has not established either area, it is unclear how the decision means generates such an analyte output signal in conjunction with the theoretical amplitude density function  $P(r,n)$ . Applicant must fully describe and recite the necessary elements for the function  $P(r,n)$  so as to definitely recite the chemical sensor system of claim 3.

**Claims 9 and 11** are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which

applicant regards as the invention. It is unclear how claims 9 and 11 further limit the subject matter of claim 3 or 4. As discussed above, in claim 9, the measurement means is recited as comprising a frequency fluctuation counter. As Applicant has only provided a frequency fluctuation counter as an example of the measurement means, such a recitation is not further limiting in claim 9. That is, the measurement means in claim 3 is specifically limited to a frequency fluctuation counter.

Likewise, in claim 11, the recitation that the decision means comprises a pattern recognizer is unclear in how such a recitation further limits claim 3 or 4. Applicant's specification only provides a pattern recognizer as an example for the decision means. That is, the decision means in claim 3 is specifically limited to a pattern recognizer. Examiner notes that the second portion of claim 11 relating to the function of the pattern recognizer is properly further limiting and definitely recited with respect to claims 3 and 4.

### ***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to NEIL TURK whose telephone number is (571)272-8914. The examiner can normally be reached on M-F, 9-630.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jill Warden can be reached on 571-272-1267. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Lyle A Alexander/  
Primary Examiner, Art Unit 1797  
NT